



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

FAX RECEIVED

MAY 10 2002

GROUP 1600

DATE:

May 9 , 2002

FROM/ATTORNEY:

Stephen A. Slusher, Reg. No. 43,924

FIRM:

Peacock, Myers &amp; Adams, P.C.

OFFICIAL

PAGES, INCLUDING COVERSHEET: 5

PHONE NUMBER: (505) 998-6130

TO EXAMINER:

A. DeCloux

ART UNIT:

1644

SERIAL NUMBER:

09/308,150

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY  
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS:

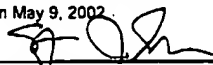
IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE  
TELEPHONE NUMBER LISTED ABOVE.

IN COMPLIANCE WITH 37 CFR 1.101, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE  
DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT  
DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE  
OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

THE DOCUMENT(S) ACCOMPANYING THIS FACSIMILE TRANSMISSION CONTAIN(S) INFORMATION FROM THE UNITED  
STATES PATENT AND TRADEMARK OFFICE WHICH IS CONFIDENTIAL AND/OR LEGALLY PRIVILEGED. THIS  
INFORMATION IS FOR THE USE OF THE INDIVIDUAL OR FIRM NAMED ON THIS SHEET. IF YOU ARE NOT THE INTENDED  
RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISCLOSURE, COPYING, DISTRIBUTION, OR THE TAKING OF ANY  
ACTION IN RELIANCE ON THE CONTENTS OF THIS INFORMATION IS STRICTLY PROHIBITED. THE DOCUMENTS SHOULD  
BE RETURNED TO THE PATENT AND TRADEMARK OFFICE IMMEDIATELY. IF THIS FACSIMILE IS RECEIVED IN ERROR,  
PLEASE NOTIFY THE ATTORNEY LISTED HEREON IMMEDIATELY.

## PATENT APPLICATION

I hereby certify that this correspondence is being facsimile transmitted to the Director of the U.S. Patent and Trademark Office (Phone No. 703-308-4315) Washington, D.C. 20231 on May 9, 2002.

  
Stephen A. Slusher, Reg. No. 43,924

May 9, 2002  
(Date)

FAX RECEIVED

MAY 10 2002

GROUP 1600

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Waltherus J.W. Van Venrooij

Serial No. 09/308,150

Filed: September 30, 1999

Examiner: A. DeCloux

Group Art Unit: 1644

For: PEPTIDE DERIVED FROM AN ANTIGEN  
RECOGNIZED BY AUTOANTIBODIES FROM  
PATIENTS WITH RHEUMATOID ARTHRITIS,  
ANTIBODY DIRECTED AGAINST SAID  
PEPTIDE, A COMBINATORIAL ANTIGEN,  
AND A METHOD OF DETECTING AUTO-  
IMMUNE ANTIBODIES

**RESPONSE AND OBJECTION TO RESTRICTION REQUIREMENT  
AND PROVISIONAL ELECTION WITH TRAVERSE**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

By Office Communication mailed April 9, 2002 (Paper 21) a restriction requirement under 35

U.S.C. § 121 has been entered. Applicants respectfully submit that the restriction requirement is improper, for the reasons set forth below. Alternatively, Applicants make the provisional election set forth below.

**The Restriction Requirement is Improper.** This is a continued prosecution application (CPA) under 37 C.F.R. § 1.53(d), which is expressly acknowledged in the initial paragraph of the Detailed Action. As discussed in MPEP § 819, second paragraph, the following is the procedure to be followed with respect to a CPA:

Ser. No. 09/308,150

Where an application filed under 37 CFR 1.53(d), a continued prosecution application (CPA), is a continuation and not a divisional, or where an application filed under former 37 CFR 1.62, File Wrapper Continuation (FWC), is a continuation and not a divisional or C-I-P, an express election made in the prior application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant. Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (1) a divisional or (2) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the examiner should make a new restriction requirement in the first action.

While the box on the CPA Request Transmittal may be marked as a "divisional application", the CPA is obviously a continuation. No claims for "an independent or distinction invention" have been submitted with respect to this CPA, as contemplated by MPEP § 201.06. The only amendments are to claims elected and pending prior to filing the CPA. To the extent necessary, Applicants request that the CPA be treated as a continuation, and not as a divisional. Applicant further expressly states that Applicants do not and did not intend to indicate that the express election made in the prior application should not carry forward in the present CPA.

As a continuation, under MPEP § 819 the previous express election carries forward. It is noted that a restriction requirement was imposed on October 10, 2000 (Paper 11), and was responded to on November 10, 2000 (Paper 12). In the next Office Action (Paper 13), in response in part to arguments made by Appellant, the restriction requirement was partially withdrawn, and "upon reconsideration the examiner has rejoined groups I, II and V, with the stipulation that Group V will be examined only to the extent of part I of claim 15, IE "a method . . . consisting of 1) a peptide according to claim 1." (Office

Ser. No. 09/308,150

Action of January 30, 2001, paragraph numbered 1 of Detailed Action.) Accordingly, the Office has proceeded to examine claims 1, 3-9, and 15-24. To impose a new restriction requirement at this stage which contradicts the Office Action of Paper 13, particularly where there is no showing that through amendment of the claims a separate and distinct need for restriction has arisen, is contrary to the purpose of a restriction requirement. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn, consonant with the prior Office Actions in this case.

**Provisional Election.** In response to the Office Action dated April 9, 2002, Applicants initially question whether the grouping is proper. Specifically, Group II is claimed to be drawn to a specific "cyclic peptide", but it is noted that Group II encompasses only claims 5 and 6, while claim 21 includes therein the peptide of SEQ ID NO:10, which is a cyclic peptide. Claim 21 is included only in Group I. However, based on the restriction as applied, the Applicants provisionally elect the claims of Group I, claims 1, 3-4, 7-9 and 17-24, as amended, respectfully traversing the restriction requirement and requesting that it be reconsidered. The Examiner has further required that the Applicants elect a specific sequence; the Applicants elect the peptide of SEQ ID NO:10, as is specified in claim 21, as amended. The Examiner has further required an election of a specific modified arginine residue; the Applicants elect a citrulline residue, such that X is NH<sub>2</sub>, Y is O, Z is NH and n is 3.

The Examiner asserts that Group I and Group II are "unique products with a distinct structure and distinct physicochemical properties." There is no more difference between Group I and Group II than there is within the members of either Group I or Group II. That is, there is no showing or teaching that some particular difference arises merely because a peptide is cyclic as opposed to linear that is not also true between different linear or cyclic peptides. Given that this is a CPA, there is no reason to believe that "a serious undue burden on the Examiner" would result from continued examination of the same claims, a search having already been conducted.

Ser. No. 09/308,150

With respect to Group III, it is submitted that this group is the same as Group V of the restriction requirement of Paper 11. Given that this claim has already been examined in two Office Actions, then subject to the limitation of rejoinder in Paper 13 restriction serves no purpose.

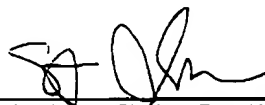
Applicants respectfully request that the restriction requirement be reconsidered and withdrawn, and that all the claims of the Application proceed to an examination upon the merits.

Should the Examiner have any comments, questions or suggestions relating to a speedy disposition of the Application, she is invited to call the undersigned at (505) 998-6130.

Respectfully submitted,

Date: May 9, 2002

By



Stephen A. Slusher, Reg. No. 43,924  
Direct line (505) 998-6130

PEACOCK, MYERS & ADAMS, P.C.  
Attorneys for Applicants  
Post Office Box 26927  
Albuquerque, New Mexico 87125-6927  
Telephone: (505) 998-1500  
Facsimile: (505) 243-2542

Customer No. 005179

I:\AMDS\Los&Stig\VanVenrooij-OA-RR-wTraverse-2.doc